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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,193	02/28/2002	Edward J. Shoen	57111-5104	8644
48276 7590 01/25/2007 TIFFANY & BOSCO CAMELBACK ESPLANADE II, THIRD FLOOR 2525 EAST CAMELBACK ROAD PHOENIX, AZ 85016			EXAMINER SALIARD, SHANNON S	
			ART UNIT 3628	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			01/25/2007	
			DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/087,193

Applicant(s)

SHOEN ET AL.

Examiner

Shannon S. Saliard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 3,5 and 26-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-25, and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/11/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse in the reply filed on 02 November 2006 is acknowledged. The traversal is on the ground(s) that the claim groups have not acquired a separate status in the art as shown by their different classification. This is not found persuasive because the Examiner believes that the restriction is proper since the subcombinations are distinct from each other and are shown to be separately usable. In the instant case, Invention I has separate utility such reporting revenue based on customer and inventory information. Invention IV has separate utility such as identifying a caller in order to process trip information. Invention III has separate utility such as notifying customers regarding an auction. Although the inventions are not separately classified, each invention would require its own separate search using different search terms.
3. The requirement is still deemed proper and is therefore made FINAL. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
4. Claims 3, 5, and 26-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 2, 4, 6, 9, and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by McCarty et al [US 5,946,660].

As per **claim 2**, McCarty et al discloses an automated self-storage management system for enabling a user to conduct self-storage transactions, the system comprising: an inventory information capture having information pertaining to self-storage units [col 11, lines 27-35; management utility program for adding and removing storage facilities]; a customer information capture having information pertaining to customers [col 7, lines 39-60; col 8, lines 4-6]; and a rental transaction feature in communication with the inventory information capture and customer information capture, wherein the rental transaction feature creates a rental agreement using information from the inventory information capture and the customer information capture, and wherein the rental

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agreement involves a plurality of self-storage units [col 6, lines 37-42; col 5, lines 56-62; col 8, lines 11-27; can select one or more storage units].

As per **claim 4**, McCarty et al further disclose an automated self-storage management system for enabling a user to conduct self-storage transactions, the system comprising: an inventory information capture having information pertaining to self-storage units [col 11, lines 27-35; management utility program for adding and removing storage facilities]; a customer information capture having information pertaining to customers [col 7, lines 39-60; col 8, lines 4-6]; a rental transaction feature in communication with the inventory information capture and the customer information capture [col 6, lines 37-42; col 5, lines 56-62; col 8, lines 11-27]; and an inventory management feature in communication with the inventory information capture, wherein the inventory management feature enables the user to modify the information pertaining to self-storage units [col 11, lines 28-35].

As per **claim 6**, McCarty et al further discloses wherein the customer information capture includes an authorized access identifier [col 8, lines 15-17].

As per **claim 9**, McCarty et al further discloses wherein the customer information capture includes a credit card identifier [col 8, lines 8-11; col 5, lines 10-12].

As per **claim 16**, McCarty et al further discloses wherein the inventory information capture comprises a map [ol 9, lines 55-56].

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1, 7, 8, 13, 14, 17-22, 24, 25, and 31** are rejected under 35 U.S.C.

103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Hafen et al [US 2003/0023453].

As per **claim 1**, McCarty et al discloses an automated self-storage management system for enabling a user to conduct self-storage transactions, the system comprising: an inventory information capture having information pertaining to self-storage units [col 11, lines 27-35; management utility program for adding and removing storage facilities]; a customer information capture having information pertaining to customers [col 7, lines 39-60; col 8, lines 4-6]; and a reporting feature in communication with the inventory information capture and the customer information capture [col 11, lines 32-35]. McCarty et al does not explicitly disclose wherein the reporting feature includes a revenue report. However, McCarty et al discloses reporting capabilities for assessing rental trends, customer tracking, and unit rental status [col 11, lines 33-36]. Also, Hafen et al discloses generating reports projecting rents to be received in the next six months and reporting daily sales [0114; 0083]. Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danyl*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a "recitation

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with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App. & Inter. 1987). Thus, the structural limitations of claim 1 are disclosed by McCarty et al as described above. Also, as described above, the functional limitations in claim 1 do not distinguish the claimed apparatus from the prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include wherein the reporting feature includes a revenue report so that interested parties can review financial projections, as suggested by Hafen et al [0114].

As per **claim 7**, McCarty et al does not explicitly disclose wherein the customer information capture includes an emergency contact identifier. However, Hafen et al discloses collecting contact information from a customer [0098; 0099]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include wherein the customer information capture includes an emergency contact identifier so facilitate easy retrieval of pertinent information.

As per **claim 8**, McCarty et al does not disclose wherein the customer information capture includes a payment history. However, Hafen et al discloses tracking historical information from rental transactions [0032]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include wherein the customer information capture includes

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a payment history. Hafen et al provides the motivation that retaining historical information to help forecast demand for rental services and provide other data mining capabilities [0032].

As per **claim 13**, McCarty et al further discloses wherein the reporting feature includes an audit report [col 11, lines 33-36].

As per **claim 14**, McCarty et al does not disclose wherein the reporting feature includes a cash intake report. However, Hafen et al discloses generating reports projecting rents to be received in the next six months [0114]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include wherein the reporting feature includes a cash intake report so that includes a revenue report so that interested parties can review financial projections.

As per **claim 17**, McCarty et al further discloses wherein the reporting feature comprises a receipt for self-storage transactions [col 6, lines 37-42].

As per **claim 18**, McCarty et al further discloses wherein the reporting feature comprises a vacancy report [col 11, lines 33-36].

As per **claim 19**, McCarty et al further discloses wherein the reporting feature comprises a facility utilization report [col 11, lines 33-35].

As per **claim 20**, McCarty et al does not disclose further comprising a communication feature configured to allow communication between users. However, Hafen et al discloses that a plurality of rental facilities may communicate [0043]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the



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invention to modify the invention of McCarty et al to include the method disclosed by Hafen et al so that the data is up-to-date.

As per **claim 21**, McCarty et al does not disclose further comprising a letter generation feature. However, Hafen et al discloses generating delinquency notices [0104; 0105]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include the method disclosed by Hafen et al so that a customer is made aware that their account is delinquent.

As per **claim 22**, McCarty et al does not disclose wherein upon occurrence of a predetermined criteria, the system generates a customer letter. However, Hafen et al discloses that a delinquent notice is sent according to a schedule [0104]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include the method disclosed by Hafen et al so that a customer is made aware that their account is delinquent.

As per **claim 24**, McCarty et al does not disclose wherein the letter pertains to a rate increase. However, Hafen et al discloses generating a notice pertaining to a rate increase [0097]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include the method disclosed by Hafen et al. Hafen et al provides the motivation that a letter pertaining to a rate increased may be required due to local laws [0097].

As per **claim 25**, McCarty et al does not disclose wherein the letter pertains to an eviction. However, Hafen et al discloses that a delinquent notice is sent according to a

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schedule [0104]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include wherein the letter pertains to an eviction so that the user is aware that the storage unit is no longer available.

As per **claim 31**, McCarty et al discloses an automated self-storage management system for enabling a user to conduct self-storage transactions, the system comprising: an inventory information capture having information pertaining to self-storage units [col 11, lines 27-35; management utility program for adding and removing storage facilities]; a customer information capture having information pertaining to customers [col 7, lines 39-60; col 8, lines 4-6]; a rental transaction feature configured to create a rental agreement using information from the inventory information capture and the customer information capture, wherein the rental agreement involves a plurality of self-storage units [col 6, lines 37-42; col 5, lines 56-62; col 8, lines 11-27], and a reporting feature in communication with the inventory information capture and the customer information capture [col 11, lines 32-35]. McCarty et al does not explicitly disclose wherein the reporting feature includes a revenue report. However, McCarty et al discloses reporting capabilities for assessing rental trends, customer tracking, and unit rental status [col 11, lines 33-36]. Also, Hafen et al discloses generating reports projecting rents to be received in the next six months [0114]. Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be

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employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App. & Inter. 1987). Thus, the structural limitations of claim 1 are disclosed by McCarty et al as described above. Also, as described above, the functional limitations in claim 5 do not distinguish the claimed apparatus from the prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include wherein the reporting feature includes a revenue report includes a revenue report so that interested parties can review financial projections, as suggested by Hafen et al [0114].

10. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660].

As per **claim 10**, McCarty et al further discloses wherein the plurality of storage units comprises a first storage unit and a second storage unit [col 8, lines 1-3], an automatic payment feature applied to the first storage unit [col 8, lines 6-12]. McCarty et al does not explicitly disclose an invoicing feature applied to the second storage unit. However, McCarty et al discloses billing system to allow a user to pay on accounts [col 11, lines 15-28]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include an invoicing feature applied to the second storage unit so pay on accounts with outstanding balances as suggested by McCarty et al [col 11, lines 25-28].

11. **Claims 11 and 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Hafen et al [US 2003/0023453] as applied to claims 2 and 22 above, and further in view of Official Notice.

As per **claim 11**, McCarty et al does not disclose comprising a transfer feature that transfers a customer from an occupied room to a vacant room. However, the Examiner takes Official Notice that it is old and well known in the rental industry at the time of the invention to move a customer from an occupied room to a vacant room. For example, when renting a hotel room, in case where the hotel is full at the time of check-in but a customer later leaves, an existing customer may ask to move to from their existing room to the empty room. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include comprising a transfer feature that transfers a customer from an occupied room to a vacant room so that a customer can receive a unit that specifically meets their needs.

As per **claim 23**, McCarty et al does not disclose wherein the letter pertains to an overdue fee. However, Hafen et al discloses that a delinquent notice is sent according to a schedule [0104]. Furthermore, the Examiner takes Official Notice that it is old and well known in the art at the time of the invention that a delinquency notice contains an overdue fee. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include wherein the

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letter pertains to an overdue fee so that the user is aware of how much he/she is responsible for paying.

12. **Claim 12** rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Hafen et al [US 2003/0023453] as applied to claim 11 above, and further in view of Official Notice and Inomata [US 6,999,825].

As per **claim 12**, McCarty et al does not disclose comprising a fee calculator that calculates a prorated rent for the occupied room and a prorated rent for the vacant room. However, Inomata discloses a fee calculator for rental of a storage unit [col 13, lines 19-26]. Furthermore, the Examiner takes Official Notice that it is old and well known in the rental industry at the time of the invention to pay only for the time in which you occupy a room. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include comprising a fee calculator that calculates a prorated rent for the occupied room and a prorated rent for the vacant room so that a user is not overcharged.

13. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al [US 5,946,660] in view of Hafen et al [US 2003/0023453] as applied to claim 1 above, and further in view of Gross [US 6,721,716].

As per **claim 15**, McCarty et al does not disclose wherein the reporting feature comprises data configured to be exported to an external financial database. However, Gross discloses exporting financial data from rental transactions [col 22, lines 21-27].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of McCarty et al to include the method disclosed by Gross so that interested parties can review financial projections.

### ***Conclusion***

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon S. Saliard whose telephone number is 571-272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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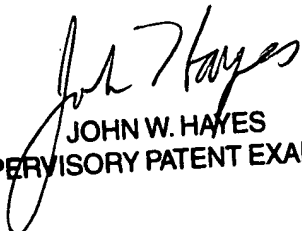
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sss

  
**JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER**

Shannon S Saliard  
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Art Unit 3628